

135.

#51

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



In re Reissue Application of: Willibald KRAUS (Appeal No. 2005-0841)

Serial No.: 08/230,083

Group Art Unit: 2749

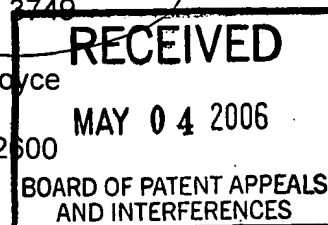
Filed: April 20, 1994

Examiner: H. Joyce

For: **CHECK VALVE ASSEMBLY**

Tech. Center: 2600

Attorney Docket No.: TRWZ 2 00136-4



MAIL STOP Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
MAY 04 2006

TECHNOLOGY CENTER R3700

BRIEF IN RESPONSE TO DECISION
Under 37 C.F.R. § 41.50(d)

This Brief is responsive to the Decision of the Board of Patent Appeals and Interferences mailed on February 22, 2006 in connection with the above-identified Appeal. Applicant accepts the Board's Invitation and pursues Option 3 and will treat the Decision as a non-final decision.

DECISION ON APPEAL UNDER 35 U.S.C. § 134

The Examiner has rejected claims 14 and 16 of the Reissue application on Appeal as being unpatentable under 35 U.S.C. § 251 based on Recapture. With respect to claim 14, a 6 to 5 majority of the panel AFFIRMED the decision of the Examiner. With respect to claim 16, the panel unanimously AFFIRMED the decision of the Examiner.

RESPONSE TO DECISION ON APPEAL

A. Introduction

1. This is an Appeal from a final rejection entered November 9, 1999 and a response to a Decision mailed February 22, 2006.

2. The Reissue application on appeal seeks to reissue U.S. Patent No. 5,105,731 (the '731 patent), issued April 21, 1992, based on Application 07/642,475, filed January 17, 1991.

3. The Reissue application contains claims 1-14 and 16.

4. Claims 14 and 16 have been rejected under 35 U.S.C. § 251 on the grounds that these claims seek to recapture subject matter surrendered when the patent sought to be reissued was granted.

5. Claim 1-13, the remaining claims, have been indicated as being allowable.

6. The principal issue decided by the Board was whether applicant has established that the Examiner erred in rejecting claims 14 and 16 based on Recapture.

7. With respect to claim 14, a 6 to 5 majority of the Panel affirmed the decision of the Examiner and, with respect to claim 16, the Panel unanimously affirmed the decision of the Examiner.

B. Findings of Fact

The Board's Decision of February 22, 2006 set out, under the heading "The Invention" a list of twenty-two (22) Findings of fact with regard to the invention set out in the '731 patent. So as to not burden the record with additional detail, applicant agrees with each of the twenty-two (22) Findings of fact statement with regard to the invention.

Next, the Board under the heading "Prosecution History of the Original Application" set out Findings of fact 23-47 set out on pages 6-11 of the Decision. Again, so as not to burden the record with additional detail, applicant agrees with each of Findings of fact 23-47.

Next, under the heading "Prosecution of Reissue Application" the Board set out Findings of fact 48-54. Again, so as not to burden the record with additional detail, applicant agrees with each of Findings of fact 48-54.

Lastly, under the heading "Examiner's Rejection" the Board set out selected details from the Examiner's rejection at Findings of fact 55-59. Applicant agrees that the Examiner did those things indicated by the Board at Findings of

fact 55-58 and further agrees that the record supports the Examiner's Findings with respect to what limitations do not appear in reissue application claims 14 and 16 which were present in claims 2 and 12 of the original application, as filed.

RECAPTURE AND REISSUE UNDER 35 U.S.C. § 251

(1)

The Statute

The Reissue patent statute expressly permits a patentee to obtain reissue claims broader than the originally issued claims at any time within two (2) years from the date the original patent issues. More particularly, 35 U.S.C. § 251, ¶¶ 1 and 4, provide in pertinent part:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall ... reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

(2)

The Judicial Doctrine

However, the scope of permissible Broadened reissue claims is limited by a judicial doctrine known as the "Recapture Rule" which prevents a patentee from regaining through a reissue patent subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. In re Clement, 131 Fed.3d 1464, 1468, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997). This is an equitable doctrine and, as the majority has pointed out, NO per se rules apply

(3)

In re Clement

The Federal Circuit's opinion in Clement discusses a three-step test for analyzing recapture.

Step 1 involves a determination of whether and in what aspect any claims sought to be reissued are broader than the patent claims. The Federal Circuit reasoned that a reissue application claim deleting a limitation or element from a patent claim is broader as to that limitation's or element's aspect. 131 F.3d at 1468, 45 USPQ2d at 1164.

Step 2 involves a determination of whether the broader aspects of the reissue application claims relate to surrendered subject matter. 131 F.3d at 1468-69, 45 USPQ2d at 1164. In this respect, review of arguments and/or amendments during the prosecution history of the application which matured into the patent sought to be reissued is appropriate. In reviewing the prosecution history, the Federal Circuit observed that "[d]eliberately canceling or amending a claim in an effort to overcome a [prior art] reference strongly suggests that the applicant admits that the scope of the claim before cancellation or amendment is unpatentable. 131 F.3d at 1469, 45 USPQ2d at 1164.

Step 3 is applied when the broadening relates to surrendered subject matter and involves a determination whether the surrendered subject matter has crept into the reissue application claim. Id. The following principles were articulated by the Federal Circuit, 131 F.3d at 1470, 45 USPQ2d at 1165:

Substep (1): if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim;

Substep (2): if it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible;

Substep (3): if the reissue claim is broader in some aspects, but narrower in others, then:

(a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;

(b) if the reissue claim is narrower in an aspect germane to a prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

(4)

North American Container

In North American Container, Inc. v. Plastipak Packaging, Inc., 415 F.3d 1335, 75 USPQ2d 1545 (Fed. Cir. 2005), the Federal Circuit rendered an opinion and applied the three-part test of Clement in a reissue context.

North American Container involved a reissue patent which had been held invalid by the U.S. District Court for the Northern District of Texas based on a violation of the Recapture Rule. During prosecution of the application for patent, the Examiner rejected the claims over a combination of two prior art references: Dechenne and Jakobsen. In response to the rejection, the applicant amended his claims by specifying that the shape of the inner walls in his invention was "generally convex." The amendments added subject matter introduced during prosecution and, presumably, not found in the claims presented for examination as originally filed. Further, the applicant also distinguished the claim invention from the prior art by making arguments including an argument that "the independent claims 15, 24, and 33 have been amended to refer to the *convex* nature of the inner wall portions of the central re-entrant portion... shape of the base as now defined in the claims differs from those of both the Dechenne patent wherein the corresponding wall portions 3 are *slightly concave*... and the Jakobsen patent, wherein the entire re-entrant portion is clearly *concave in its entirety*. The claims containing the "generally convex" limitation were subsequently allowed and issued from a continuation application.

Within the two-year period provided for by 35 U.S.C. § 251, the patentee filed a broadening reissue application retaining all 18 of the originally-allowed claims and adding 14 new, broader claims. Of particular relevance was that the newly added claims deleted the claim language "inner wall portions are

generally convex" because, according to the patentee, "the invention is not limited to such a structure."

Of particular relevance in the North American Container situation is that the claim limitation "wherein said inner wall portions are generally convex" was subject matter introduced during prosecution of the original patent in order to distinguish over the prior art and, was specifically argued by applicants during prosecution in an effort to distinguish those claims with the newly introduced subject matter over the references of record.

The Federal Circuit in North American Container agreed with the District Court's conclusion that the applicant, through argument during prosecution disclaimed inner walls of the base portion having any concavity.

Further, the Federal Circuit agreed with the District Court that NAC violated the Recapture Rule

[w]e agree that NAC violated the recapture rule, and thus the reissue claims are invalid. Applying our three-part test, we find that the reissue claims are broader in scope than the originally-issued claims in that they no longer require the "inner walls" to be "generally convex." Moreover, the broader aspect of the reissue claims relates to subject matter that was surrendered during prosecution of the original-filed claims. Indeed, during prosecution, the applicant conceded that the pending independent claims "have been amended to refer to the convex nature of the inner wall portions of the central re-entrant portion" '607 Application Paper No. 6, at 10. The applicant even argued that the "shape of the base as *now defined* in the claims differs from those of ... the Dechenne patent, wherein the corresponding wall portions are slightly concave."

(5)

Ex parte Eggert

The precedential opinion rendered in Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003) is part of the recapture precedent applicable to proceedings before the United States Patent and Trademark Office (USPTO). Eggert was entered on May 29, 2003, prior to the Federal Circuit's North American Container decision. As outlined by the Board in their Decision, the

Eggert majority stated that "[in] our view, the surrendered subject matter is the outer circle of drawing 1 [the rejected claim prior to the amendment that resulted in the claim being issued] because it is the subject matter appellants conceded was unpatentable." 67 USPQ2d at 1717. The majority further held that "in our view" subject matter narrower than the rejected claim but broader than the patent claim is not barred by the Recapture Rule. Id.

(6)

Subject Matter Surrendered According to the Board

The Board in the Decision mailed February 22, 2006 took the view that the majority view in Eggert is inconsistent with the subsequent Federal Circuit Decision in North American Container with respect to the principles governing application of Substep (3)(a) of Clement.

The Board majority stated in the record that

North American Container holds that the "inner walls" limitation (a portion of the issued claim that was added to the rejected claim by the amendment) was "subject matter that was surrendered during prosecution of the original-filed claims." 415 Fed3d at 1350, 75 USPQ2d at 1557. It is believed that the Substep (3)(a) rationale of the Eggert majority (1) is not consistent with the rationale of the Federal Circuit in North American Container and (2) should no longer be followed or be applicable to proceedings before the U.S.P.T.O.

Therefore, according to the Board majority, in cases involving Substep (3)(a) of Clement, the subject matter surrendered is:

The subject matter of an application claim which was amended or canceled and on a limitation-by-limitation basis, the territory falling between the scope of (a) the application claim which was canceled or amended and (b) the patent claim which was ultimately issued.

THE BOARD'S POSITION IS IMPROPER

As noted above, the Board majority took the position that North American Container stands for the proposition that the surrendered subject matter is the subject matter of an application claim which was amended or canceled and, on a limitation-by-limitation basis, the territory falling between the scope of the application claim which was canceled or amended and the patent claim which was ultimately issued. It is respectfully submitted that this rigid definition adopts a per se rule which is contrary to the language of 35 U.S.C. § 251 which permits broadened claims in a reissue patent. The Board has taken a per se rule of reissue recapture to prevent applicant from retreating to any claim limitation determined to have secured allowance of the original patent. In North American Container, the applicant added limitations during prosecution and argued those limitations. This does not require the per se rule adopted by the majority.

Applicant's decision not to appeal the Examiner's original rejection of claims 1 and 3-11 but to amend the allowable claims into independent form may be considered to constitute an irrevocable admission that claims of the scope of claims 1 and 3-11 are unpatentable. Applicant had his chance to test the correctness of the Examiner's rejection by way of Appeal to this Board and chose not to do so. Instead, the applicant chose to rewrite allowable dependent claim 2 into independent form as new claim 15 to include all of the limitations of its base claim 1. Similarly, applicant chose to amend allowable claim 12 into independent form as new claim 16 to include all of the limitations of its base claim 1 and intervening claims 10 and 11. Thus, applicant cannot retreat all the way through the "shaded area" in the Eggert analysis being defined by claims 1 and 3-11.

In addition to the above, the Board majority's own position against per se rules is set out in the Decision at least on page 22 where, as noted by the Board majority, the Clement steps should not be viewed as per se rules.

WHAT WAS SURRENDERED

As noted by Judge Nase with others in the concurring-in-part and dissenting-in-part, in the context of recapture under 35 U.S.C. § 251, surrendered subject matter has been determined by the Supreme Court, the Federal Circuit, or

the Court of Customs and Patent Appeals (CCPA) to be either (1) the rejected claim to be deliberately canceled or amended in an effort to overcome a prior art rejection (which strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable); or (2) the argued claim minus the argued limitations when surrender occurs through arguments alone. Judges Nase, Garris, Delmendo, and Franklin are aware of no 35 U.S.C. § 251 recapture case in which the Supreme Court, the Federal Circuit, the CCPA or the Court of Claims determined that surrendered subject matter includes both the subject matter of a rejected claim that is subsequently amended into allowable form and, on a limitation-by-limitation basis, the territory falling between the scope of the rejected claim and the amended allowable claim.

Similarly, applicant is also unaware of any reissue case under 35 U.S.C. § 251 in which it has been determined that surrendered subject matter includes both the subject matter of a rejected claim that is subsequently amended into allowable form and, on a limitation-by-limitation basis, the territory falling between the scope of the rejected claim and the amended allowable claim.

Therefore, consistent with the view taken by Judges Nase, Garris, Delmendo, and Franklin, applicant here is of the view that, in this Appeal, the prosecution history of Application No. 07/642,475 set forth in the plurality opinion establishes only each of original patent application claims 1, 3-5, and 7-11 as surrendered subject matter since the appellant either canceled or amended each of those claims in order to overcome a prior art rejection.

THIS VIEW IS CONSISTENT WITH FEDERAL CIRCUIT DECISIONS

Applicant's view is consistent with Clement which, as set out by Judges Nase, Garris, Delmendo, and Franklin compared reissue claim 49 with claim 42 before the amendments thereto which made claim 42 allowable. The "found that the broadening of claim 49 to eliminate the room temperature and specific energy limitations of step (a) and the temperature, specific energy and pH values of steps (c) and (d) was a broadening directly related to several prior art rejections. In an effort to overcome the applied prior art, Clement added the "room temperature" and "energy" limitations.

In Clement, subject matter that was introduced during prosecution of the original patent was added in order to secure allowance of the claims. Also, applicant argued that the invention differed from the prior art based on the amendments made to the claim adding the limitations.

Further, this view is consistent with Pannu v. Storz Instruments Inc., 258 Fed.3d 1366, 1370-71, 59 USPQ2d 1597, 1600 (Fed. Cir. 2001) where the court stated that "[o]n reissue, [Pannu] is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections." Again, in Pannu, the limitation at issue added to original patent claim 16 was due to a later Examiner's Amendment setting forth structural details of Haptics in the claimed invention. In Pannu, amendments were made to the claims adding limitations and arguments were presented in support of patentability of those claims.

Still further, like the view from Judges Nase, Garriss, Delmendo, and Franklin, the view is consistent with North American Container because, as the prosecution history shows, amendments were made to the claims adding subject matter which was introduced during prosecution of the original patent and, correspondingly, arguments were presented into the record. It is clear that in North American Container, the surrendered subject matter included the limitation of the shape of the inner walls being "generally convex" because this limitation was both argued by applicants as well as introduced during prosecution of the original patent in order to distinguish the claims over the prior art.

THIS VIEW IS CONSISTENT WITH RECENT PRECEDENTIAL OPINIONS OF THE BOARD

In Ex parte Yamaguchi (Exhibit 1), original application claims 1-14 were allowed in the first Office Action. The claims were allowed as originally filed, except for a few minor amendments made by the Examiner with the authorization of the appellant's attorney.

Three of the Office Action in the Allowance set out in the Examiner's Statement of Reasons for Allowance. Essentially, the Examiner's reasons for allowance listed each and every element of the allowed claims.

In the reissue application at hand, appellant sought to delete from the original patent claim 1 the language contained in the application claim 1

allowed as filed and included in the Examiner's Statement for Reasons for Allowance. Thus, in Yamaguchi, the application for reissue sought to enlarge the scope of claims as originally filed but subject to an Examiner's Statement of Reasons for Allowance. In the reissue application, the Examiner considered the claims to be unpatentable because they were considered to be an improper recapture of broadened claimed subject matter surrendered in the application. Specifically, the Examiner took the position that

The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. § 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The patent claims 1-14 were allowed on the basis of Examiner's Statement of Reasons(s) for Allowance,. . . [quoted supra].

Claim 1, as presented in this reissue application seeks to broaden the coverage by the removal of the limitation of, the third axis [is] disposed inside [of] a triangle defined by the first, second and fourth axes viewed on end.

Since applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue, the omitted limitation is thus established as relating to subject matter previously surrendered.

At the time of Yamaguchi, the present 37 C.F.R. § 1.104(e) was not in effect. However, the Board in the appeal on reissue on Yamaguchi took the position that "even if present 37 C.F.R. § 1.104(e) had been in effect when appellants original application was pending, we do not consider that the Recapture Rule would preclude them from obtaining the claims now on appeal."

The Board there considered the precedent set down by the court in Hester Industries, 1402 Fed.3d at 1481, 46 USPQ2d at 1648 and took the position that:

In the present case, the claims in appellant's original application were, as noted previously, allowed in the first Office Action. Consequently, the prosecution history of the original application contains none of the evidence relevant to surrender discussed in Hester Industries ..., in that it contains neither any

amendments to the claims, nor any arguments made by appellants to overcome prior art or for any other purpose.

APPLICATION OF YAMAGUCHI IN THE PRESENT REISSUE APPLICATION

Similar to the situation in Yamaguchi, original application claims 2 and 12 were allowable as filed. Had all of the original application claims 1-14 been written into independent form at the original application, claims 2, 6, and 12-13 would have allowed as filed. Instead, because applicant used the dependent claim format for the convenience of the Office, and to save filing costs, allowable claims 2 and 12 were written in dependent format and were based on independent claim 1 and, in the case of claim 12, included the limitations of intervening claims 10 and 11.

The Board's per se rule of "what subject matter is surrendered" would not apply to claims 2, 6, and 12-14 had they been written and filed in independent form. Applicant made no arguments on the record as correctly noted by the Board in the majority's decision and, further, no additional subject matter was introduced during prosecution of the original patent. Still further, in the underlying original application, the Examiner never provided a Statement of Reasons for Allowance.

EXAMINER'S PRIMA FACIE CASE RECAPTURE

Applicant respectfully submits that the Examiner has not made a prima facie case of recapture. The majority decision indicates that Findings of fact 55-58 set out the basis upon which the Examiner made a recapture rejection. They further note that in Finding 58, the Examiner's Findings are supported by the record. First, this argument is circular because the Examiner did not have the advantage of the majority's decision in the reissue application applying the new Findings in connection with the North American Container holding. The majority first rewrites Substep (3)(a) of Clement and then indicates that "the Examiner's accurate factual analysis demonstrates that the Examiner has made out a prima facie case of recapture" which, according to the majority, can be made out "by establishing that the claims sought to be reissued fall within Substeps (1) or (3)(a) of Clement." (decision page 23)

In addition to the above, the Examiner did not make out a prima facie case of recapture because the Examiner simply adopted a per se rule and compared elements of the original application claims against elements of the issued patent claims and further in view of elements of the reissue application claims. No deference was given to decisions from the Federal Circuit and, particularly, with regard to decisions from this Board including precedential opinions such as, for example, the opinion set down in Eggert.

With regard to opinions from the Federal Circuit, the Examiner never provided in the record explanations on the manner in which original patent claims 1 and 11 included portions of surrendered subject matter when, essentially, those combinations of limitations were allowed in the original application claims 2 and 12 as filed. The Examiner simply applied a per se claim element comparison and, with regard to reissue claim 14 took the position that the surrounding rim carrying rib members was lacking and, with regard to reissue claim 16, that the locking element being guided over a dove-tail guide was lacking. The Examiner gave no deference to the prosecution history which, as noted above, applicant made no unmistakable assertions to the Patent Office in support of the patentability of the claims and, further, added no new subject matter introduced during prosecution of the original patent in order to distinguish over the prior art.

VIEW OF ONE SKILLED IN THE ART

The majority in the Decision took the further position that applicant has not satisfactorily explained "why at the time of the amendment one skilled in the art would not reasonably viewed the subject matter broader than the narrowing amendment to original application claims 3-5 and 7-11 as having been surrendered." Further, the majority positioned applicant's argument as embracing a per se rule to be based on Eggert. Applicant, however, did not argue for a per se rule, however, but merely followed the Eggert analysis.

First, one of ordinary skill in the art would likely view original application claim 15 as being the combination of all of the limitations presented in base claim 1 and dependent claim 2. In viewing the limitations presented in claim 15, one of ordinary skill in the art would not necessarily place any additional

weight on the limitations carried into claim 15 and sourced from claim 2 above and beyond the limitations sourced from claim 1. Similarly, one of ordinary skill in the art would not necessarily be inclined to place any additional weight on the limitations presented in base claim 1 above and beyond the weight carried by the limitations from dependent claim 2. The limitations assembled in claim 15 from claims 1 and 2 are of equal weight. The Examiner has taken the position that any claim in the reissue application which does not contain the limitations set out in original application claim 2 would constitute impermissible recapture. However, one of ordinary skill in the art might look to the limitations of claim 1 and conclude that any claims in the reissue application which do not include the limitations of original application claim 1 would constitute impermissible recapture. The record is clear that applicant neither argued the patentability of claim 2 nor tendered any amendment to either claims 1 or 2 but, rather, simply added new independent claim 15 which included, equally, all of the limitations of base claim 1 and allowable claim 2 as originally filed.

Similarly, one of ordinary skill in the art would look to original application claim 16 and conclude that it included all the limitations of base claim 1 as well as those of dependent claims 10 and 11 and allowable claim 12. The Examiner in the recapture rejection has placed an unreasonable weight on the limitations of claim 12 when it is clear from the record that applicants never amended any of claims 1, 10, 11, or 12 but, rather, simply presented a new independent claim 16 including all of the limitations of claim 12 allowable as filed together with base claim 1 and intervening claims 10 and 11.

REISSUE CLAIM 14 ANALYSIS

In order to best help facilitate an analysis of claim 14 using the above guidelines, appellant has prepared Table I below illustrating the differences between original application claim 1, patent claim 1, and reissue claim 14. As can be seen below in the Table, reissue claim 14 is broader than patent claim 1 in the "aspect" that the reissue claim 14 does not include the limitation of "wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10)

joining the stays (9)". Also, reissue claim 14 does not include the limitation that the resilient clip connection is "carried on the outer housing."

Having determined that the reissue claim 14 has been broadened relative to patent claim 1, the next step is to "determine whether those broadenings" relate to surrendered subject matter." Also, in order to determine whether an applicant surrendered particular subject matter, one must turn to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

To the above end, applicant respectfully notes that during prosecution, original application claims 2, 6, and 12-14 contained allowable subject matter as filed. In an amendment, without argument regarding the merits of the art of record, claim 1 was canceled and original application claim 2 was rewritten into independent form as new claim 15 to include all of the limitations of claim 2 and base claim 1 as filed. Accordingly, the only subject matter that could be considered to have been "surrendered" by applicant in the original prosecution could only have been the scope of independent claim 1 as originally filed. Original application claim 1 is repeated below in Table I.

Appellant respectfully points out that the above analysis is wholly consistent with North American Container as well as with the Eggert application of the Clement test. In Eggert, after a review of the prosecution history, it was determined that appellants added the language "said retaining member being generally bowl-shaped and convex toward said magnet" to claim 1 in response to a final rejection in order to overcome the prior art rejection based on the Parsons patent in view of the Clark and Miller patents. The Board in Eggert concluded that appellants, in adding that limitation, conceded that claim 1 prior to the amendment was not patentable, thereby surrendering the subject matter of that claim. The Board determined that the deliberate amendment of claim 1 in an effort to overcome the prior art rejection was an admission that the scope of the claim before the amendment was unpatentable and establishes that subject matter as surrendered subject matter. Therefore, in the case at hand, the surrendered subject matter is claim 1 of the original application (the "outer circle" of the Eggert drawing).

As noted above, the second step in determining whether the recapture rule is applicable is to ascertain whether the broader aspects of the reissue claims relate to the surrendered subject matter [original application claim 1]. With regard to the rejected reissue claims at hand, appellant respectfully submits that the first broader aspect of the reissue claim 14, is the absence of the limitation of "wherein the inner frame 4 has a surrounding rim 7 carrying rib members 8 spaced transversely with stays 9 extending therefrom and a surrounding frame 10 joining the stays 9". As shown above, "surrendered" subject matter is the scope of canceled original patent claim 1 set out above. Since original application claim 1 did not include the rim, rib member and stay limitations, these broader aspects of reissue claim 14 are germane to the prior art rejection in the original application. Next, with regard to the second broader aspect of reissue claim 14, namely the absence of the limitation of the resilient clip connection being "carried on the outer housing", it is respectfully submitted that the omission of that limitation in the reissue claim is not an aspect germane to the prior art rejection during prosecution. Applicant never argued this limitation during prosecution and the Examiner did not require it in the allowable subject matter.

The next stage in the inquiry is to compare the rejected reissue claims to the surrendered subject matter to determine in what aspects the reissue claims are broader than the surrendered subject matter [original application claim 1] and in what aspects the reissue claims are narrower than the surrendered subject matter [original application claim 1]. The reissue claim 14 is broader than the surrendered subject matter in that the limitation of the resilient clip connection being "carried on the outer housing" has been omitted. However, this omitted limitation clearly relates to features which were not argued by appellants as distinguishing over the applied prior art during prosecution of the original patent application. Thus, it is respectfully submitted that this limitation is not germane to any prior art rejections contained in the original prosecution.

Next, it must be determined if the reissue claims are narrower than the surrendered subject matter [original application claim 1]. (Eggert, p 1731). Here, reissue claim 14 has been narrowed relative to both the surrendered subject matter [original application claim 1] and the patent claim 1 in that reissue

claim 14 limits the first clip connection as comprising "a first springy tongue spaced from the surrounding wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall." Reissue claim 14 has only been broadened relative to the surrendered subject matter [original application claim 1] in that the limitation of the resilient clip connection being "carried on the outer housing" is absent. However, this limitation is not germane in any way to the prior art rejection of original application claim 1. Alternatively, appellant respectfully submits that the limitation of the resilient clip connection being "carried on the outer housing" is inherent in the language of reissue claim 14.

Appellant again respectfully refers the Board to Table I below which compares the reissue claim 14 with canceled original application claim 1. As can be seen from the Table, reissue claim 14 has the same scope as the surrendered subject matter in an aspect germane to the prior art rejection (i.e., "wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and surrounding frame (10) joining the stays (9)). More particularly, neither the surrendered subject matter (original claims) nor reissue claim 14 include this limitation. Thus, the surrendered subject matter has not been expanded by the scope of reissue claim 14. Further, reissue claim 14 is broader only in aspects unrelated to the rejection (i.e., the resilient clip connection being "carried on the outer housing"). Again, however, appellant respectfully submits that the limitation of the resilient clip connection being "carried on the outer housing" is inherent in the language of reissue claim 14.

Therefore, it is respectfully submitted that in the case at hand, based upon the above, reissue claim 14 falls into the either category (2) or category (3)(b) as described by Clement.

The majority in Eggert suggests that the narrowing of the reissue claim does not have to be in the same aspect of the invention, as long as the narrowing overcomes the rejection of the canceled claim. In that regard, applicant has attached hereto a copy of a Notice of Allowability at Exhibit 3 which shows that the Examiner allowed claims 1-14 and 16 in this reissue application on the merits against the prior art background. Accordingly, it is respectfully submitted

that reissue claim 14 overcomes the rejection of the canceled claim (claim 1) and falls entirely within the outer circle in the Eggert Analysis defined by originally filed claim 1.

It is respectfully submitted that reissue claim 14 falls entirely within the outer circle in the Eggert Analysis. Original application claim 1 recites a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, the assembly comprising an outer housing, an inner frame, a check valve element, and a resilient clip connection. In reissue claim 14, a check valve assembly is recited adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising an outer housing, an inner frame, a check valve element, and a resilient clip connection. In original application claim 1, the outer housing is connected with the inner frame. In reissue claim 14, the outer housing has an open end and a surrounding wall and the inner frame is received within the open end. First and second resilient clip connections join the outer housing with the inner frame. In original application claim 1, the check valve element is formed of a flexible sheet material clamped between the outer housing and the inner frame. In reissue claim 14, the check valve element is formed of a flexible sheet material and is clamped between the outer housing and the inner frame. In original application claim 1, the inner frame is received into the open end of the outer housing. Reissue claim 14 places the inner frame received in the open end of the outer housing. Original application claim 1 recites the inner frame, the outer housing, and the check valve being joined to a support of the motor vehicle through a resilient clip connection carried on the outer housing. Reissue claim 14 recites a first and second resilient clip connection joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle.

As is apparent from the above, reissue claim 14 falls entirely within the "outer circle" in the Eggert Analysis, the outer circle being defined by original application claim 1.

In addition to the above, reissue claim 14 adds the further limitation of the first clip connection comprising a first springy tongue spaced from the

surrounding wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall.

Again, as is apparent from the above, reissue claim 14 includes limitations beyond those presented in original application claim 1 and, therefore, falls entirely within the outer circle in the Eggert Analysis. Reissue claim 14 is narrower than the scope of the rejected claim (claim 1).

Therefore, for at least the above reasons, applicant respectfully submits that reissue claim 14 is allowable and does not violate the Recapture Doctrine according to the Eggert analysis.

REISSUE CLAIM 16 ANALYSIS

Appellant has prepared Table II below illustrating the differences between patent claim 11 and reissue claim 16. As can be seen below in the Table, reissue claim 16 is broader than patent claim 11 in the "aspect" that the reissue claim 16 does not include the limitation of "said locking element (30) being guided over a dove-tail guide (31) on the outer surface of the outer housing (3)".

However, this is irrelevant as reissue claim 16 is narrower than the surrendered subject matter (original application claims 1/10/11) in the aspect that claim 16 includes the limitation of "the slip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle."

To the above end, appellant respectfully notes that during prosecution, original application claims 2, 6, and 12-14 contained allowable subject matter as filed. In an amendment, without argument regarding the merits of the art of record, claims 1 and 12 were canceled and original application claim 12 was rewritten into independent form as new claim 16 to include all of the limitations of base claim 1 and intervening claims 10 and 11 as filed. Accordingly, using the analysis set out in Eggert, the only subject matter that could have been "surrendered" by applicant in the original prosecution could only have been the scope of independent claim 1 as originally filed combined with dependent claims 10 and 11 as originally filed. Original application claim 1 is repeated below in Table II together with a column including claims 10 and 11.

As noted above, the second step in determining whether the recapture rule is applicable is to ascertain whether the broader aspects of the reissue claims relate to the surrendered subject matter. With regard to the rejected claims at hand, appellant respectfully submits that the broader aspects of the reissue claim 16, namely the absence of the limitation of "said locking element (30) being guided over a dove-tail guide (31) on the outer surface of the outer housing (3)" was not contained in claims 1, 10, or 11 and was required in claim 12 for patentability. Hence, the omission of this limitation in reissue claim 16 is germane to the prior art rejection. Also, this implies that the "surrendered" subject matter could only have been derived from the scope of canceled original patent claims 1, 10 and 11 set out above.

Appellant respectfully refers the Board to Table II below which compares the reissue claim 16 with canceled original application claims 1, 10, and 11. Using the analysis set out in Eggert, a determination must be made whether the broadenings of the claims during prosecution relate to surrendered subject matter. A review of the prosecution history as set out above reveals that the additional language of claim 12 (i.e., "said locking element (30) being guided over a dove-tail guide (31) on the outer surface of the outer housing (3)") was necessary to secure an allowance over original base claim 1 and intervening claims 10 and 11. Thus, in conceding that claims 1, 10, and 11 were not patentable, the subject matter of those claims formed the surrendered subject matter for consideration herein. Hence, the omission of this limitation in reissue claim 16 is in an aspect germane to the prior art rejection.

Still further following the Eggert analysis, the next stage in the inquiry is to compare the rejected reissue claims to the surrendered subject matter to determine in what aspects the reissue claims are broader than the surrendered subject matter and in what aspects the reissue claims are narrower than the surrendered subject matter. Reissue claim 16 is in no way broader than the surrendered subject matter [original application claims 1, 10, and 11]. Each and every limitation of the surrendered subject matter finds a corresponding limitation in reissue claim 16.

Next, a determination must be made if the reissue claims are narrower than the surrendered subject matter. With reference again to Table II, reissue claim 16 has been narrowed relative to the surrendered subject matter in that it includes the limitation of "the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle." Reissue claim 16 has the same scope as the surrendered subject matter in an aspect germane to the prior art rejection (i.e., "said locking element (30) being guided over a dove-tail guide (31) on the outer surface of the outer housing (3)"). More particularly, neither the surrendered subject matter (original claims 1, 10, and 11) nor reissue claim 16 includes this limitation. Thus, the surrendered subject matter has not been expanded by the scope of reissue claim 16.

Therefore, it is respectfully submitted that in the case at hand based upon the above, reissue claim 16 falls into either category (2) or (3)(b) as described by Clement.

The majority opinion in Eggert suggests that the narrowing of the reissue claim does not have to be in the aspect of the invention, as long as the narrowing overcomes the rejection of the canceled claim. In that connection, applicant has enclosed herewith a copy of a Notice of Allowability in this reissue application whereat the Examiner has allowed claims 1-14 and 16 on their merits over the art of record. It is respectfully submitted that reissue claim 16 is patentable over the prior art and is narrower than the scope of the rejected claim (original claims 1, 10, and 11) and, accordingly, falls entirely within the outer circle in the Eggert Analysis.

Reissue claim 16 is narrower than the scope of the rejected claim (claim 11) and, accordingly, does not recite surrendered subject matter and is therefore allowable under the Eggert Analysis. More particularly, original application claim 11 recites a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, the assembly comprising an outer housing, an inner frame, a check valve element, and a resilient clip connection. In reissue claim 16, a check valve assembly is recited adaptable for use with a ventilation system of a passenger space of a motor

vehicle, the assembly comprising an outer housing, an inner frame, a check valve element, and a resilient clip connection. In original claim 11, the outer housing is connected with the inner frame. In reissue claim 16, the outer housing has an open end and the inner frame is received in the open end, the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle. In original patent claim 11, the check valve element is formed of a flexible sheet material clamped between the outer housing and the inner frame. In reissue claim 16, the check valve element is formed of a flexible sheet material clamped between the outer housing and the inner frame. In original claim 11, the assembled unit comprising the inner frame, the outer housing, and the check valve are joined to a support of the motor vehicle through a resilient clip connection carried on the outer housing. In reissue claim 16, a resilient clip connection is provided formed separate from the outer housing and carried on a locking element which is connected with the outer housing, the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle. In original application claim 10, the resilient clip connection comprises a springy tongue formed separate from the outer housing. In reissue claim 16, the resilient clip connection is formed separate from the outer housing and is carried on a locking element. In original application claim 11, the springy tongue of the clip connection is arranged on a locking element which can be connected with the outer housing. In reissue claim 16, the resilient clip connection is formed separate from the outer housing and is carried on a locking element which is connected with the outer housing.

As can be seen from the above, reissue claim 16 is narrower than the scope of the rejected claim (claims 1, 10, 11) and, therefore, falls entirely within the outer circle in the Eggert Analysis.

Accordingly, reissue claim 16 should be allowed and the rejection under the recapture rule withdrawn.

Therefore, for at least the above reasons, applicant respectfully submits that reissue claim 16 is allowable and does not violate the Recapture Doctrine according to the Eggert analysis.

**RELATION OF "FIRST" AND "SECOND" EMBODIMENTS TO REISSUE
APPLICATION CLAIMS 14 AND 16**

The majority opinion invited applicant to discuss whether, and how, what they referred to as a "first" and "second" embodiment (Findings 18-22) falls within the scope of (1) reissue application claims 14 and 16 vs. (2) the patented claims.

First, the majority called a "first" embodiment of the invention as including a clip connection which can include a springy resilient tongue 22' and cited to the '731 patent at column 5, lines 17-18. The majority called the "second" embodiment a clip 6 without a dove-tail guide having a springy tongue 22, all, according to them, as shown in detail in Figures 6, 7, and 8 and discussed at column 4, line 31 through column 5, line 15 of the '731 patent.

Reissue claim 14 is directed to the embodiment shown in Figure 1 wherein the first clip connection 6 (at the top of Figure 1) comprises a first springy tongue spaced from the surrounding wall and the second clip connection 6 (bottom of Figure 1) comprises a second springy tongue integral with the surrounding wall. As can be seen from Figure 1, the top clip connection 6 is spaced apart from the surrounding wall 21 whereas the bottom clip connection 6 is formed integral with the surrounding wall.

Reissue claim 16 is directed to the embodiment shown in Figures 9-11 wherein the springy resilient tongue 22' is made separately as an independent piece relative to the outer housing 3. For this embodiment the tongue 22' is arranged and supported on a locking element 30 which can be connected with the outer housing. With reference to Figure 9, the locking element is moved into position by being pushed over the dove-tail guide on the wall 21. It is pushed in until, as shown in Figure 9, the edge 33 grips behind a stop surface 32 on the outer housing 3. With the completion of this step, the locking element 30 is secured on the surrounding wall 21 of the outer housing 3. Thereafter, the assembled unit can be mounted on a vehicle wall such as shown in Figure 1 whereupon the front zone of the springy tongue 22 can strike against the support 2. Thus, in this form of construction and in a very simple way, a functionally secure fastening of the whole unit to a support 2 is assured. Essentially, the

opposite vertical sides (as viewed in Figure 9) of the springy tongue 22 are used to connect the locking element 30 with the dove-tail guide and thereafter, the entire assembly to the associated vehicle support 2. Thus, reissue claim 16 and, in particular, the limitation of "the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle" is the embodiment shown in Figures 9-11.

Original patent claims 1-6 are directed to the "second" embodiment identified by the majority in Findings 18-22. Claims 7 and 8 of the '731 patent are directed to both the "first" and "second" embodiments set out by the majority in Findings 18-22. Lastly, original patent claims 9-13 are directed to the "first" embodiment set out by the majority in Findings 18-22.

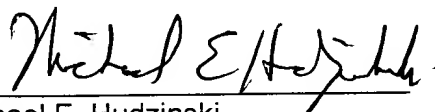
CONCLUSION

In view of the above comments and arguments presented, applicant respectfully submits that reissue claims 14 and 16 are in condition for allowance under the recapture doctrine.

Allowance of all claims and early notice to that effect is respectfully requested.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP



Michael E. Hudzinski
Reg. No. 34,185
1100 Superior Avenue
Seventh Floor
Cleveland, Ohio 44114-2518
(216) 861-5582

N:\TRW\Z\200136\4A\bjb0004519V001.doc

CERTIFICATE OF MAILING

I certify that this **Brief in Response to Decision** Under 37 C.F.R. 1.136(a) and accompanying document(s) are being

- ☒ deposited with the United States Postal Service as First Class mail under 37 C.F.R. § 1.8, addressed to: MAIL STOP Appeal Brief- Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
- ☐ transmitted via facsimile under 37 C.F.R. § 1.8 on the date indicated below.
- ☐ deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP , Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Express Mail Label No.:
Date
April 24, 2006

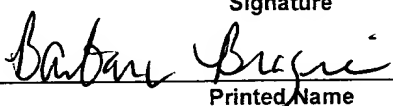
Signature

Printed Name
Barbara Brazier

TABLE I

Original Application Claim 1	Patent Claim 1	Reissue Claim 14
1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	14. A <u>check valve assembly</u> adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising:
an <u>outer housing</u> to which	an <u>outer housing</u> to which	an <u>outer housing</u> having an open end and a surrounding wall;
an <u>inner frame</u> is connected with	an <u>inner frame</u> is connected with	an <u>inner frame</u> received in the open end;
a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3); and,	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3); and,	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame; and,
the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3).	the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve element (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3); and,	first and second <u>resilient clip connections</u> joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle,
	wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9).	
		the first clip connection comprising a first springy tongue spaced from the surrounding wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall.

TABLE II

Original Application Claim 1	Original Dependent Claims 10, 11	Patent Claim 11	Reissue Claim 16
1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:		11. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	16. A <u>check valve assembly</u> adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising:
an <u>outer housing</u> to which		an <u>outer housing</u> to which	an <u>outer housing</u> having an open end;
an <u>inner frame</u> is connected with		an <u>inner frame</u> is connected with	an <u>inner frame</u> received in the open end
a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and		a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame; and,
the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3).		a <u>resilient clip connection</u> (6) carried on the outer housing (3) and, wherein the clip connection (6) comprises a springy tongue (22')	a <u>resilient clip connection</u>
	10. The assembly as defined in claim 1 wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3).	<u>formed separate</u> from the outer housing (3), said springy tongue (22') being <u>arranged on a locking element</u> (30)	<u>formed separate</u> from the outer housing and <u>carried on a locking element</u>

Original Application Claim 1	Original Dependent Claims 10, 11	Patent Claim 11	Reissue Claim 16
	11. The assembly as defined in claim 10 wherein the springy tongue (22') is arranged on a locking element (30) which can be connected with the outer housing (3).	which can be <u>connected with the outer housing</u> (3), and	which is <u>connected with the outer housing</u>
		said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3).	
			the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle.

Exhibit 1



RECEIVED

MAY 04 2006

TECHNOLOGY CENTER R3799

PRECEDENTIAL OPINION

Pursuant to the Board of Patent Appeals and Interference's Standard Operating Procedure 2, Rev. 4, the opinion below has been designated a precedential opinion. This opinion was entered July 31, 2001, and reported as a non-precedential opinion of the Board at 61 USPQ2d 1043.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOZO YAMAGUCHI and YOSHINORI MIYAISHI

Appeal No. 2001-1596
Application 09/296,102

ON BRIEF

Before CALVERT, FRANKFORT, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an application for reissue of patent No. 5,643,119 (the patent), which issued on July 1, 1997, based on Application 08/574,914, filed December 19, 1995 (the original application). The instant application was filed on April 21, 1999.

Appeal No. 2001-1596
Application 09/296,102

Appellants seek review of the final rejection of August 4, 2000 (Paper No. 7), in which the examiner rejected claims 1 to 14 as being unpatentable for failure to comply with 35 U.S.C. § 251. Claim 15, the other claim in the application, was indicated as being allowable if rewritten in independent form.

Background

The patent contains 14 claims. Claim 1, the only independent claim, reads (emphasis added):

1. A hybrid vehicle powertrain, comprising:
an internal combustion engine for driving an engine output shaft and thereby generating mechanical energy;
a generator for converting said mechanical energy into electricity;
an electric motor driven by said electricity to output rotational power at a motor output shaft;
a differential gear unit including at least three elements, the first connecting to said generator, the second connecting to a first gear and the third connecting to said internal combustion engine;
a second gear connected to said motor output shaft; and
a counter shaft connected to an output differential gear unit and having mounted thereon a third gear meshing with the first and second gears; and
wherein said internal combustion engine, differential gear unit and generator are aligned on a first axis, said electric motor is aligned on a second axis parallel to the first axis, said counter shaft is aligned on a third axis parallel to the first and second axes, said output differential gear unit is aligned on a fourth axis parallel to the first, second and third axes, and the third axis is disposed inside of a triangle defined by the first, second and fourth axes viewed on end.

Appeal No. 2001-1596
Application 09/296,102

A review of the file of the original application shows that claims 1 to 14 were allowed in the first Office action (Paper No. 7, Nov. 19, 1996). The claims allowed were as originally filed, except for a few minor amendments made by the examiner with the authorization of appellants attorney.¹ Page 3 of the action included the following paragraph:

The following is an examiner s statement of reasons for allowance: The prior art of record does not disclose or render obvious a motivation to provide for a powertrain as defined by the limitations of claim 1, including an internal combustion engine and a generator both connected to a differential and all three are aligned on a first axis, the electric motor aligned on a second parallel axis, a counter shaft aligned on a third axis having a gear which meshing [sic: meshes] with the second gear of the motor and the first gear of the differential and which countershaft is also connected to an output differential mounted on a fourth axis, and the third axis is inside a triangle defined by the first, second and fourth axes viewed on end.

Appellants were then advised that [a]ny comments considered necessary by applicant [sic] must be submitted no later than the payment of the issue fee (action, page 4).

In the present reissue application, appellants seek to delete from patent claim 1 the language underlined above, and to

¹The examiner inserted -powertrain - after hybrid vehicle in the preamble of each of claims 1 to 14; changed said in line 13 of claim 1 to -an output -; inserted - output - after first and second axes, said in line 20 of claim 1; and inserted -output - after for driving said in line 2 of claim 2.

Appeal No. 2001-1596
Application 09/296,102

include it in a new dependent claim 15, appellants asserting in paragraph 7 of the new reissue declaration (filed Jan. 4, 2000) that this language was erroneously included in claim 1 [and] was not necessary either for a complete definition of our invention or for distinguishing the prior art. Thus, the application seeks to enlarge the scope of claims 1 to 14 of the patent, and was properly filed within two years from the grant of the patent, as provided by the fourth paragraph of 35 U.S.C. § 251. However, the examiner considers claims 1 to 14 to be unpatentable under § 251 because they are an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based (answer, page 3). Specifically, the examiner takes the position that (answer, pages 3 to 4):

The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. § 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The patent claims 1-14 were allowed on the basis of Examiner's Statement of Reason(s) for Allowance, . . . [quoted supra].

Claim 1, as presented in this reissue application, seeks to broaden the coverage by the removal of the limitation of, the third axis [is] disposed inside [of] a triangle defined by the first, second and fourth axes

Appeal No. 2001-1596
Application 09/296,102

viewed on end.

Since applicant did not present on the record a counter statement or comment as to the examiner's reasons for allowance, and permitted the claims to issue, the omitted limitation is thus established as relating to subject matter previously surrendered.

Opinion

After reviewing the record in light of the arguments presented in appellants' brief and in the examiner's answer, we conclude that the rejection is not well taken.

35 U.S.C. § 251 provides that a patent may be reissued if it is deemed wholly or partly inoperative or invalid through error without any deceptive intention. Under the recapture rule, there cannot be said to be an error within the meaning of § 251 [i]f the patentee tries to recapture what he or she previously surrendered in order to obtain allowance of original patent claims. Mentor Corp. v. Coloplast Inc., 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993).

The reissue statute is based on fundamental principles of equity and fairness, and should be construed liberally. Hester Industries, Inc. v. Stein, Inc., 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998), quoting In re Weiler, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986). When the Office action allowing the claims in the original application was issued on

Appeal No. 2001-1596
Application 09/296,102

Nov. 19, 1996, the rule concerning reasons for allowance, 37 CFR § 1.109, provided in its last two sentences (emphasis added):

The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

Effective Dec. 1, 1997, § 1.109 was removed and its substance incorporated into § 1.104 as § 1.104(e) (1203 O.G. 63, 79 (Oct. 21, 1997)). Subsequently, effective Nov. 7, 2000, § 1.104(e) was amended by deleting its last sentence (underlined above), the accompanying discussion stating that this statement in the rule was obsolete and out of step with recent case law and citing as examples of such case law four decisions of the United States Supreme Court and Court of Appeals for the Federal Circuit² (1238 O.G. 77, 103 (Sep. 19, 2000)).

Appellants argue that, in not filing a statement or comments in response to the examiner's reasons for allowance, they were entitled to rely on the above-noted provision of the last

² Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 41 USPQ2d 1865 (1997); Markman v. Westview Instruments, 52 F.3d 967, 34 USPQ2d 1321 (Fed. Cir. 1995), aff'd, 517 U.S. 320, 38 USPQ2d 1461 (1996); Vitronics Corp. v. Conceptron Inc., 90 F.3d 1576, 39 USPQ2d 1573 (Fed. Cir. 1996); Zenith Labs., Inc. v. Bristol-Myers Squibb Co., 19 F.3d 1418, 30 USPQ2d 1285 (Fed. Cir. 1996).

Appeal No. 2001-1596
Application 09/296,102

sentence of 37 CFR § 1.109/1.104(e), i.e., that failure to file such a statement would not give rise to any implication that they agreed with or acquiesced in the examiner's reasoning. We agree. It has been held that an applicant should be entitled to rely on the statutes, Rules of Practice and provisions of the MPEP in the prosecution of his patent application. In re Kaghan, 387 F.2d 398, 401, 156 USPQ 130, 132 (CCPA 1967). The examiner here appears to be of the opinion that the 37 CFR § 1.109/1.104(e) provision negating any implication of acquiescence from applicant's failure to respond to the examiner's reasons for allowance was in some manner invalid because contrary to case law. However, it is well settled that the rules of the PTO have the force and effect of law unless they are inconsistent with statutory provisions, In re Rubinfeld, 270 F.2d 391, 395, 123 USPQ 210, 214 (CCPA 1959), cert. denied, 362 U.S. 903 (1960), and neither any of the cases cited in footnote 2, supra, nor any other decision of which we are aware, has specifically held this provision of 37 CFR § 1.109/1.104(e) to be inconsistent with the statute or otherwise invalid. To penalize appellants for having relied on a provision of the rules which was in effect at the time of their reliance would be contrary to the fundamental principles of equity and fairness on which the reissue statute is

Appeal No. 2001-1596
Application 09/296,102

based. Hester Industries, supra.

In effect, the examiner seems to be retroactively applying the Nov. 7, 2000 amendment of the rules, supra, by which this provision was removed from § 1.104(e), but an agency does not have the authority to promulgate retroactive rules unless expressly given that authority by Congress, Motion Picture Assn. of America Inc. v. Oman, 969 F.2d 1154, 1156, 23 USPQ2d 1447, 1449 (D.C.Cir. 1992), and the PTO has not been given such authority.

Moreover, even if present 37 CFR § 1.104(e) had been in effect when appellants original application was pending, we do not consider that the recapture rule would preclude them from obtaining the claims now on appeal.

Discussing what may constitute a surrender for purposes of the recapture rule, the Court in Hester Industries, 142 F.3d at 1481, 46 USPQ2d at 1648, stated that:

as a general proposition, in determining whether there is a surrender, the prosecution history of the original patent should be examined for evidence of an admission by the patent applicant regarding patentability. . . . In this regard, claim amendments are relevant because an amendment to overcome a prior art rejection evidences an admission that the claim was not patentable. . . . Arguments made to overcome prior art can equally evidence an admission sufficient to give rise to a finding of surrender. . . . Logically, this is true even when the arguments are made in the absence of any claim amendment. Amendment of a claim is

not the only permissible predicate for establishing a surrender.

In the present case, the claims in appellants original application were, as noted previously, allowed in the first Office action. Consequently, the prosecution history of the original application contains none of the evidence relevant to surrender discussed in Hester Industries, supra, in that it contains neither any amendments to the claims³, nor any arguments made by appellants to overcome prior art or for any other purpose. Appellants only argument was their lack of response to the examiner s statement of reasons for allowance, and we know of no decision which holds that, under the recapture rule, a surrender may result from an applicant s failure to act, as opposed to taking a positive action such as changing the claims or presenting an argument.

However, even if it might be considered that, by analogy to prosecution history estoppel, a surrender may arise from an applicant s failure to file a statement or comments in response to the examiner s statement of reasons for allowance⁴, it is not

³ Except for the minor amendments made by the examiner (see footnote 1, supra) which are not relevant here.

⁴ For example, such a lack of response was considered as a factor in the prosecution history limiting the interpretation of

Appeal No. 2001-1596
Application 09/296,102

evident here what appellants could be said to have surrendered by their non-response. As they aptly state on page 12 of their brief:

The nature of the examiner's statement of Reasons for Allowance did not invite any counter statement or comment. Comparing the examiner's Reasons for Allowance with claim 1 as issued, it can be appreciated that the Reasons for Allowance were merely a paraphrasing of substantially the entirety of claim 1. . . . The fact that the examiner's Reasons for Allowance were simply a restatement of the entirety of claim 1 as allowed, indicates that the examiner did not attribute patentability to any one or several features recited by the claim but, rather, found that the claim as a whole distinguished over the prior art, a conclusion which no applicant would want to dispute because it amounts to no more than a recognition that the whole of a claim must be considered in determining its patentability. Panduit Corp. v. Dennison Manufacturing Co., [810 F.2d 1561,] 1 USPQ2d 1593 (Fed. Cir. 1987). Applicants could not have reasonably be [sic: been] expected to argue against such a finding.

If the examiner's position here were carried to its logical conclusion, appellants would be precluded by the recapture rule from enlarging the scope of their patent claim 1 in any respect whatsoever. In our view, such an interpretation of the recapture rule would improperly have the effect of nullifying that portion of § 251 which permits, where appropriate, enlarging the scope of patent claims. This would be contrary to the purpose of the

the patent claims in Elkay Mfg. Co. v. Ebco Mfg. Co., 192 F.3d 973, 979, 52 USPQ2d 1109, 1113-14 (Fed. Cir. 1999).

Appeal No. 2001-1596
Application 09/296,102

reissue statute, which is to remedy errors. In re Bennett, 766
F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985).

Conclusion

We conclude that appellants surrendered nothing during the
prosecution of their original application. Consequently, the
recapture rule is inapplicable here, and the examiner's decision
to reject claims 1 to 14 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

IAC:pgg

Appeal No. 2001-1596
Application 09/296,102

Lorusso & Loud
3137 Mount Vernon Avenue
Alexandria, VA 22305